

REMARKS/ARGUMENTS

With this amendment, claims 1 – 12, and 15 are in the application. Reconsideration is respectfully requested for the reasons set forth below.

Request for Entry of Claim Amendment

Independent claim 1 is amended here. As amended, claim 1 essentially incorporates the subject matter of now cancelled claims 19, 20, and 21 and, therefore, presents no new issues for consideration. Additionally, as explained below, other terms have been added to claim 1 for the purpose of addressing informalities pointed out by the Examiner.

Since no new issues have been raised as a result of these amendments, and the amendments place the application in a better condition for allowance (or, in the event that the Examiner is not willing to allow the present application, in a better condition for appeal), entry of the claim amendments is respectfully requested.

Claim Rejections Under 35 USC § 101.

Claim 1 and the claims depending therefrom were rejected under Section 101 as failing to disclose a tangible result. The rejection grounds state that:

“The body of the claim does not provide the use or purpose for returning a probability. Applicant should amend the claims to show how ‘returning a probability’ can be used for accomplishing a purpose, thus providing a tangible result.”

Applicant appreciates the Examiner’s helpful suggestion in this regard and, in reply, applicant has amended the claim (final clause) to show how the returned probability is used. Specifically, information that is based on the returned probability is provided to the user, and that information comprises search results that are refined in a manner that corresponds to the returned probability so that the user may determine from the refined search results a geographical location.

Applicant believes that the foregoing amendment will permit the Examiner to withdraw the rejection of the claims under 35 USC § 101.

Claim Rejections Under 35 USC § 112, First Paragraph

The subject matter of claims 19 and 21 (now part of claim 1) was rejected as lacking description in the specification.

Specifically, claim 19 was rejected as lacking support for the expression “*separating*” (from other text criteria) “*text criteria that is not a locality name.*” In reply, applicant notes that beginning on page 4, line 24, the specification describes how the location module parses the search criteria and divides the submitted text into text which is or might be locality names and text which is not a locality name. The specification goes on to note that the comparator tests only the is-or-might-be-a-locality-name-text against a table of known locality names. Applicant submits that the foregoing adequately supports the claim language objected to by the Examiner. Nonetheless, applicant is willing to amend that language to substitute the word “dividing” for “separating” if the Examiner wishes, although applicant believes such verbatim conformance of the claim and specification is not required in this instance.

The limitation of claim 21 “*search results that are refined in a manner corresponding to the returned probability*” was rejected as being new matter (failing the Section 112 description requirement). The Examiner also asserts that the disclosure is insufficient in defining the “manner” applicant is referring to.

In reply, applicant refers to the two paragraphs beginning on page 5, line 21 of the original specification. There it is noted that, for example, the search engine makes a determination of which of the two returned geographical locations was intended by the user, the manner of that determination is indicated as “*preferably by electing the higher of the two probabilities [returned to the search engine].*” Applicant submits that the disclosed example of sorting search results fully supports the claim limitation: “*search results that are refined in a manner corresponding to the returned probability.*” One of ordinary skill, therefore, would understand that this limitation is met, for example, by sorting the returned results based upon the previously returned probability.

Applicant believes that the foregoing explanation will permit the Examiner to withdraw the rejection under 35 USC § 112, first paragraph.

Claim Rejections Under 35 USC § 112, Second Paragraph

Claim 1 has been amended to remove the “processor means” term and to return that limitation to a method-type. Applicant believes that this addresses the rejection made on the top of page 4 of the office action.

As to the Examiner’s question of why in claim 1 information is returned, applicant notes that the user submits search criteria that include a locality name. The claim makes it clear that

what is submitted is not then simply returned. Rather, what is returned is a *probability* that the submitted name is associated with a geographical location. Moreover, the final paragraph of claim 1 now more thoroughly answers the question of why this probability is returned. It is used to provide information (for example, a ranked list) from which the user may determine a geographical location. Applicant believes that claim 1, as amended, is fully compliant with Section 112.

Claim 11 specifies a lookup table that associates locality names and geographic locations. In the office action, the Examiner asked “*To what is the locality name and geographic name associated to?*” In reply applicant notes that the claim has been amended to specify that locality names are associated *to* geographic names. Applicant believes that this resolves any indefiniteness that may be associated with this claim.

Claim 19 included language, now in claim 1, indicating that the criteria submitted by the user “*may be in the form of text.*” The Examiner objects to this language as constituting “*language that ... makes optional ... steps to be performed or does not limit the scope of the claim.*” In connection with this rejection, the applicant is referred to MPEP § 2106 II. However, the pertinent paragraph (C) of that MPEP section is intended for providing guidance as to how claims are to be construed in the overall analysis of determining patent subject matter eligibility. While that section does indicate statements of optional use or the like may not require steps to be performed, that section does not state that such limitations should be rejected as indefinite under 35 USC §112.

Applicant submits that MPEP § 2106 does not require rejection of claims that, although not further limiting the claim, may serve a useful purpose, as here, in establishing antecedent basis for other claim limitations. On the other hand, MPEP Section 2173.05(h) (“*Alternative Limitations*”) makes it clear that the question is not whether the limitation presents an option. The question is whether that option or alternative limitation is unambiguous. (citing *In Ex parte Cordova*, 10 USPQ2d 1949 (Bd. Pat. App. & Inter. 1989) the language “*containing A, B, and optionally C*” was considered acceptable alternative language because there was no ambiguity as to which alternatives are covered by the claim. A similar holding was reached with regard to the term “*optionally*” in *Ex parte Wu*, 10 USPQ2d 2031 (Bd. Pat. App. & Inter. 1989)).

In the case at hand the claimed limitation unambiguously states that the search criteria may be in the form of text. Accordingly, applicant submits that the language under consideration is unobjectionable under 35 USC § 112, second paragraph.

Claim Rejections Under 35 USC § 102

The Examiner has averred that the present invention is anticipated by the disclosure of US Patent No. 6,249,252 (Dupray). In forming the rejection grounds against claim 1, the Examiner refers to column 46, lines 47 to 67, which describes a trucking company making an internet request to a disclosed location center in Denver to determine if a particular truck is in the Denver area.

The precise interpretation of the Dupray document made by the Examiner is not transparent and there are some alternative interpretations which the examiner may be applying. In the spirit of expediting the prosecution of the application, alternative interpretations are next explored in the context of traversing the rejection.

Using the terminology of the claim, the claimed “user” appears to be read onto the disclosed “trucking company” and the claimed “locality name” appears to be read onto the disclosed Denver request.

Although the request is made about Denver, the request is made to the location center in Denver. Hence, it seems very unlikely (and it is certainly not disclosed) that the query includes the term “Denver” as a locality name.

The Examiner appears to argue that the truck is in a cell and that the disclosed “cell” can therefore be read on to the claimed “geographical location” because the truck is at the same location as the cell.

Carrying this interpretation through the claim, the returning step requires “returning, in dependence on Denver (the locality name) a probability that Denver is associated with a cell”.

This is clearly not what occurs in Dupray or in the present invention because any given cell will have a fixed location. Or in the very least, will always be within the Denver area – in the case of a mobile base station for example (otherwise the Denver locality center would not be aware of the cell’s existence).

Taking a different interpretation, if the claimed “locality name” is intended to read on to the disclosed “truck” then the user does not submit a locality name but rather a truck identifier

(presumably).

The Examiner's parallels between "cells" and "truck locations" do not apply because the user does not submit the cell identifier. This would require the user to be aware of the location of the truck already and hence negate the need to determine its location.

In short, applicant submits that a rejection under 35 USC § 102 has not been properly made here because the office action fails to show where in Dupray each and every element as set forth in the claim is found, either expressly or inherently. Accordingly, the rejection of claim 1 and the claims depending therefrom should be withdrawn.

Conclusion

In view of the foregoing, applicant believes that all of the currently pending claims are in condition for allowance, and an early notification to that effect is respectfully requested. If the Examiner has any questions, she is invited to contact applicant's attorney at the below-listed telephone number.

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